

REMARKS/ARGUMENTS

In the Office Action mailed July 7, 2008, claims 1-6, 9-11, 13, and 14 were rejected. Additionally, claims 7 and 8 were objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicants hereby request reconsideration of the application in view of the below-provided remarks. No claims are amended, added, or canceled.

Allowable Subject Matter

Applicants appreciate the Examiner's review of and determination that claims 7 and 8 recite allowable subject matter. In particular, the Office Action states that claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Additionally, while the Office Action provides a statement of reasons for the indication of allowable subject matter, the Office Action's statement is directed to specific aspects of certain claims and not necessarily all of the claims. Applicants note that the Office Action's comments may have paraphrased the language of the claims and it should be understood that the language of the claims themselves set out the scope of the claims. Thus, it is noted that the claim language should be viewed in light of the exact language of the claim rather than any paraphrasing or implied limitations thereof.

Reopening of Prosecution after Appeal

Although not addressed in the present Office Action, Applicants note that the Examiner appears to have reopened prosecution after appeal. Apparently, the prosecution was reopened in order to enter a new ground of rejection for claims 1, 13, and 14 under 35 U.S.C. 112, first paragraph. Also, the previous rejections of claim 1-6, 9-11, 13, and 14 under 35 U.S.C. 103(a) are maintained.

Withdrawal of Finality

As a preliminary matter, Applicants respectfully assert that the finality of the present Office Action is premature. In particular, the finality of the present Office Action is premature because the amendments filed on August 17, 2007, are not a proper basis for making the present Office Action final. As a matter of clarification, the MPEP states that an Office action containing a new ground of rejection may be made final, after reopening prosecution following appeal, if the new ground of rejection was 1) necessitated by amendment, or 2) based on information presented in an information disclosure statement, under certain conditions. MPEP 1207.04.

The present Office Action presents a new ground of rejection because the Office Action rejects claims 1, 13, and 14 under 35 U.S.C. 112, first paragraph. No previous rejection of these claims was presented prior to Applicants' Appeal Brief filed on April 29, 2008. Furthermore, no information disclosure statement has been filed under the conditions set forth in the MPEP. Hence, the present Office Action can only be made final if necessitated by an amendment.

In this case, there was no amendment filed in the response immediately preceding the Appeal Brief. While an amendment was filed previously on August 17, 2007, during prosecution of the present application, no new grounds of rejection were presented in the Office Action mailed November 2, 2007, following that amendment. Thus, it appears that the amendment filed on August 17, 2007, did not necessitate a new ground of rejection at the time of the amendment. Therefore, it appears to be inappropriate to suggest that the same amendment filed on August 17, 2007, now might necessitate a new ground of rejection, when the same language previously did not necessitate a new ground of rejection. In other words, although the new grounds of rejection are directed at the language of the indicated amendment, the failure to present a new rejection in the Office Action immediately following the indicated amendment indicates that the presently issued new grounds were not necessitated by the language of the amendment, even though the language is now referred to in the new grounds of rejection.

Since the amendment presented on August 17, 2007, is only now considered the basis for a new rejection, after several other interceding papers have been filed by the Examiner and Applicants in the present application, Applicants respectfully submit that

the finality of the present Office Action is improper because the amendment did not necessitate the new grounds of rejection. Accordingly, Applicants assert that the finality of the present Office Action is premature and request that the finality of the present Office Action be withdrawn.

Claim Rejections under 35 U.S.C. 112, first paragraph

Claims 1, 13, and 14 were rejected under 35 U.S.C. 112, first paragraph, as purportedly failing to comply with the written description requirement. Specifically, the Office Action states that the limitation “inductor being variable during operation” of claims 1, 13, and 14 has no clear and descriptive support in the specification of the present application. However, Applicants respectfully disagree with the Office Action’s assertion because the present application provides ample support for the indicated limitation.

While the specification may not provide explicit antecedent basis for the exact language used in the claims, explicit antecedent basis is not required to support the language of the claims. See, MPEP 608.01(o) (“an applicant is not limited to the nomenclature used in the application as filed”). Furthermore, 37 C.F.R. 1.75(d)(1) requires that the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable. In other words, support is required, and antecedent basis is simply one way of providing support, but is not the only way to provide support for the limitations of the claim.

In the present application, Applicants respectfully submit that indicated limitation related to “at least one of the first inductor and the second inductor being variable during operation of the receiver” is supported by the specification, even though there may not be explicit antecedent basis for the language. As examples, this language is supported by the subject matter described at page 2, lines 1-4 (“with at least one of [the first and second] inductors being variable for aligning the receiver”); page 2, lines 5-9 (“making the receiver means alignable by introducing at least one variable inductor or coil at least either coupled to the receiver antenna or in the receiver oscillating-filtering circuit”); page 2, lines 9-12 (“one or two variable inductors are sufficient to align the receiver with

respect to the transmitter”); page 4, lines 18-22 (“one or two variable inductors in the receiver”); page 6, line 31, through page 7, line 2 (“an inductor 54 (variable coil)”; page 7, lines 4-5 (“By varying inductor 54 [in the receiver matching network 22], the receiver 2 can be aligned with respect to the transmitter 1.”); page 8, lines 15-16 (“By varying inductor 79 [in the receiver oscillating-filtering circuit 24], the receiver 2 can be aligned with respect to the transmitter 1.”).

It should further be noted that the plain meaning of a variable inductor is an inductor with an inductance value that can vary during operation. In other words, the inductance of a variable inductor is variable during operation. One possible reason for varying an inductor during operation is to tune a circuit, as explained in the present application. More specifically, a receiver may be tuned to a transmitter by varying the inductance value of an inductor during operation of the receiver. The plain meaning of the term “variable inductor” described in the present application inherently provides the possibility to vary the inductance value during operation. In more specific detail, the present application also describes a variable coil as a particular example of a variable inductor. Within this context, the description of the variable coil indicates that the inductance value of the variable coil may be varied, or changed, during operation of the circuit in which the variable coil is located.

Based on the descriptions in the present application of variable inductors and varying an inductor to align a receiver with a transmitter, as well as the plain meaning of these terms, Applicants respectfully submit that the indicated language finds considerable support in the specification. Here, although the language of the claims differs somewhat from the actual nomenclature provided in the specification, Applicants respectfully submit that the claim language is nevertheless supported by the specification because the claims recite limitations that are well within the scope of the embodiments described in the specification. Moreover, although the MPEP indicates that the use of a variety of terms can be confusing, Applicants respectfully submit that the terms used in the claims do not cause such confusion. On the contrary, the language of the claims is ascertainable from the specification, as shown by the explanation provided above.

Therefore, Applicants assert the claims are supported by the specification as filed because the language is within the scope of the written description provided in the

specification, and the language does not cause confusion as to the meaning of the claims. Accordingly, Applicants respectfully request that the rejections of claims 1, 13, and 14 under 35 U.S.C. 112, first paragraph, be withdrawn.

Claim Rejections under 35 U.S.C. 103

Claims 1-3, 9, and 13-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shore (U.S. Pat. No. 5,742,902, hereinafter Shore) and in view of Lin (U.S. Pat. No. 5,983,084, hereinafter Lin). Additionally, claims 4-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shore as modified by Lin and further in view of Hunter (U.S. Pat. Pub. No. 2,824,170, hereinafter Hunter). Additionally, claims 10 and 11 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Shore as modified by Lin and further in view of Melbourne (U.S. Pat. No. 6,774,787, hereinafter Melbourne). However, Applicants respectfully submit that these claims are patentable over Shore, Lin, Hunter, and Melbourne for the reasons provided below.

Independent Claim 1

Claim 1 recites “a receiver amplifying-shaping circuit coupled to the receiver oscillating-filtering circuit via a receiver filtering circuit; with at least one of the first inductor and the second inductor being variable during operation of the receiver for aligning the receiver” (emphasis added).

In contrast, the combination of cited references does not teach an inductor which is variable during operation of a receiver. The Office Action relies on Shore as purportedly teaching a variable inductor, and does not assert that any other references might teach a variable inductor. However, Shore does not teach a variable inductor, despite the assertions in the Office Action.

While Shore teaches several different inductors, none of the described inductors is a variable inductor. The inductor L1, which is used to advance phase of the RF signal, is described as having a specific inductance of 33 nH. Shore, col. 3, lines 60-62. Similarly, the inductor L20, which is used to set the oscillation of the quench oscillator, is described as having a specific inductance of 220 nH. Since these inductors have specific inductance values, these inductors are not variable inductors.

Although Shore also describes a potential range of inductance values for some of the inductors L22, L40, and L42, Shore does not describe any of these inductors as being variable inductors. Shore merely describes selecting an inductor, having a specific inductance value within the specified range of values, for use in the described circuits. In other words, Shore describes the ability to use an inductor with a specific, non-variable inductance value, even though another instance of the same circuit arrangement may use an inductor with another specific, non-variable inductance value. More specifically, Shore does not describe any of the inductors as being capable of changing its own inductance value. Therefore, Shore does not describe a variable inductor, as recited in claim.

Moreover, Shore does not describe an inductor being variable during operation of a receiver. Even if the circuit arrangements in Shore potentially allow independent implementations to have different inductance values, Shore nevertheless does not describe any functionality to change, or vary, an inductance value of an inductor during operation of the corresponding circuit arrangement.

Additionally, the Examiner's attempt to analogize between the description of Shore and the subject matter described in the specification of the present application does not support the present rejection. Although the Examiner appears to assert that Shore purportedly teaches variable inductors because both Shore and the present application describe different ranges of values for inductors, this broad and sweeping generalization of the teachings of Shore nevertheless does not support the assertion that Shore might teach inductors which are variable during operation. As explained in Applicants' previous responses, Shore simply does not teach any functionality to change the inductance value of an inductor during the operation of the inductor. Rather, the description of Shore merely describes using different values within a circuit, presumably set upon design of the circuit, without specifying that the values might change during operation.

For these reasons, Applicants submit that the rejection of claim 1 is improper at least because the cited references do not teach all of the limitations of the claim. In particular, the cited references do not teach a variable inductor, as recited in claim.

Accordingly, Applicants respectfully submit that claim 1 is patentable over the cited references.

Independent Claim 13

Applicants respectfully assert independent claim 13 is patentable over the combination of cited references at least for similar reasons to those stated above in regard to the rejection of independent claim 1. In particular, claim 13 recites “a receiver amplifying-shaping circuit coupled to the receiver oscillating-filtering circuit via a receiver filtering circuit; with at least one of these inductors being variable during operation of the receiver for aligning the receiver” (emphasis added).

Here, although the language of claim 13 differs from the language of claim 1, and the scope of claim 13 should be interpreted independently of claim 1, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejection of claim 13. Accordingly, Applicants respectfully assert claim 13 is patentable over the combination of cited references because Shore does not teach a variable inductor, as recited in claim, and the Office Action does not provide a proper motivation to a modify the references.

Independent Claim 14

Applicants respectfully assert independent claim 14 is patentable over the combination of cited references at least for similar reasons to those stated above in regard to the rejection of independent claim 1. In particular, claim 14 recites “a receiver amplifying-shaping circuit coupled to the receiver oscillating-filtering circuit via a receiver filtering circuit; with at least one of these inductors being variable during operation of the receiver for aligning the receiver” (emphasis added).

Here, although the language of claim 14 differs from the language of claim 1, and the scope of claim 14 should be interpreted independently of claim 1, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejection of claim 14. Accordingly, Applicants respectfully assert claim 14 is patentable over the combination of cited references because shore does not teach a

variable inductor, as recited in claim, and the Office Action does not provide a proper motivation to modify the references.

Dependent Claims

Claims 2-11 depend from and incorporate all of the limitations of independent claims 1. Applicants respectfully assert claims 2-11 are allowable based on an allowable base claim. Additionally, each of claims 2-11 may be allowable for further reasons.

CONCLUSION

Applicants respectfully request reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,

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